REMARKS

In the Final Office Action[1], the Examiner rejected claims 1-3, 5-17, 19-31, 33-46, and 48-61 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,068,797 to Sansone et al. ("*Sansone*"), U.S. Publication No. 2002/0032573 to Williams et al. ("*Williams*"), and U.S. Patent No. 5,072,401 to Sansone et al. ("*Sansone '401*") in view of U.S. Patent No. 5,043,908 to Manduley et al. ("*Manduley*"); and rejected claims 4, 18, 32, and 47 under 35 U.S.C. § 103(a) as being unpatentable over *Sansone, Williams, Sansone '401*, and *Manduley* in view of OFFICIAL NOTICE and *Rothe Dev. Corp. v. U.S.*, No. 00-1171 (Fed. Cir. Aug. 20, 2001) ("*NPL_SDB*").

By this response, Applicants amend claims 1, 3, 4, 8, 15, 17, 18, 22, 29, 31, 32, 36, 43, 46, 47, 51, and 57.

I.   Telephonic Interview of February 4, 2011

Applicants thank the Examiners for the courtesies extended during the telephonic interview of February 4, 2011. The Examiners asserted that the claimed invention was similar to what was designated as prior art in the specification. Applicants disagree, but to further highlight the distinction between the prior art and the claimed invention, Applicants have amended claims 1, 3, 4, 8, 15, 17, 18, 22, 29, 31, 32, 36, 43, 46, 47, 51, and 57.

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[1] The Final Office Action contains a number of statements reflecting characterizations of the related art, case law, and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

II.   Rejection of Claims 1-3, 5-17, 19-31, 33-46, and 48-61 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-3, 5-17, 19-31, 33-46, and 48-61 as being unpatentable over *Sansone, Williams,* and *Sansone '401* in view of *Manduley.* A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)(internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.,* 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). In rejecting a claim, "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). Here, no *prima facie* case of obviousness has been established for at least the reason that the Office Action has not properly determined the scope and content of the prior art and has not properly ascertained the differences between the prior art and the claimed combinations.

Claim 1 recites a method comprising, for example, "determining, using [a] computer system, routes for delivery based on a first set of business rules applied to [a] first set of delivery data and a second set of business rules applied to [a] second set of delivery data" (emphasis added). *Sansone* fails to teach or suggest at least these elements of claim 1.

Sansone discloses "[a] system and method for optimizing mail delivery of batch mail." (*Sansone*, abstract). A "data center receives batch mail data from []

users . . . and also receives carrier and route data from the Post Office . . . . On the basis of this information, the data center determines the optimum carriers and routes to employ for transporting the mail between the various post offices . . . and communicates this determination to the Post Office . . . ." (*Sansone*, col. 14, line 62 - col. 15, line 2).

The Final Office Action asserts that *Sansone's* "routes to employ for transporting the mail" constitute the claimed "routes for delivery" and *Sansone's* "batch mail data" constitute the claimed "delivery data." (Final Office Action at pages 2-3). The Final Office Action also asserts that *Sansone's* disclosure of "evaluation of delivery routes" and "types of carriers" as well as *Sansone's* disclosure of "selecting routes" constitute support for the use of the claimed "business rules." (*Id.*). However, even if these assertions are correct, which Applicants do not concede, *Sansone* fails to teach or suggest the above-quoted elements of claim 1 as amended.

Sansone's "data center" does not determine *Sansone's* "routes to employ for transporting the mail" based on <u>a first set of business rules</u> applied to a first set of *Sansone's* "batch mail data" <u>and a second set of business rules</u> applied to a second set of *Sansone's* "batch mail data." Therefore, *Sansone* also fails to teach or suggest "determining, using the computer system, routes for delivery based on <u>a first set of business rules</u> applied to the first set of delivery data <u>and a second set of business rules</u> applied to the second set of delivery data," as recited in claim 1 (emphasis added).

Williams fails to cure the deficiencies of *Sansone*. *Williams* discloses "a plurality of Enterprises with a single online user interface with which the Enterprise can provide Enterprise Shippers, shipping origination users and shipping intermediary users with an automated parcel management system for a plurality of supported Carriers for a plurality of services." (*Williams*, abstract). "Centralized reports provide Shipping Managers with the information required to negotiate the most favorable rates with Carriers and to audit Carrier performance." (*Williams*, ¶ 27).

However, *Williams* does not disclose determining routes for delivery based on different sets of business rules applied to different sets of delivery data. Therefore, *Williams* also fails to teach or suggest "determining, using the computer system, routes for delivery based on <u>a first set of business rules</u> applied to the first set of delivery data and <u>a second set of business rules</u> applied to the second set of delivery data," as recited in claim 1 (emphasis added).

Sansone '401 fails to cure the deficiencies of *Sansone* and *Williams*. *Sansone '401* discloses "the delivery of individual batches to various stations external to the Postal Service or internal to the Postal Service, and . . . logistics planning generally to expedite processing of bulk mail." (*Sansone '401*, col. 9, lines 57-60). "The system allows a decision to be made as to the best way of handling particular mail at the mailer's site, based on such factors as transport costs to local Post Office, postage costs, delivery times, estimated Post Office processing time, available Post Office equipment, Post Office workloads, available discounts, E-Mail processing costs, and others of a similar nature." (*Sansone '401*, col. 10, lines 1-8).

However, *Sansone '401* does not disclose determining routes for delivery based on different sets of business rules applied to different sets of delivery data. Therefore, *Sansone '401* also fails to teach or suggest "determining, using the computer system, routes for delivery based on <u>a first set of business rules</u> applied to the first set of delivery data <u>and a second set of business rules</u> applied to the second set of delivery data," as recited in claim 1 (emphasis added).

Manduley fails to cure the deficiencies of *Sansone*, *Williams*, and *Sansone '401*. *Manduley* discloses "[a] self-monitoring mail delivery system wherein mail is tracked as it passes through multiple delivery stages." (*Manduley*, abstract). "[A] database is maintained at [a] data center which by polling of [] various stations along [a] route, or by inputs from the stations when the mail piece arrives, automatically keeps current track of the mail piece along its route." (*Manduley*, col. 2, lines 56-60).

However, *Manduley* does not disclose determining *Manduley's* "route" based on different sets of business rules applied to different sets of delivery data. Therefore, *Manduley* also fails to teach or suggest "determining, using the computer system, routes for delivery based on <u>a first set of business rules</u> applied to the first set of delivery data <u>and a second set of business rules</u> applied to the second set of delivery data," as recited in claim 1 (emphasis added).

In view of the above, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. For at least these reasons, no *prima facie* case of obviousness has been established. The rejection of claim 1, and dependent claims 2, 3, 5-14, and 58, under 35 U.S.C. § 103(a) as being obvious from *Sansone*, *Williams*,

and *Sansone '401* in view of *Manduley* is thus improper and should be withdrawn.

Independent claims 15, 29, 43, and 57, though of a different scope from claim 1, recite

elements similar to those set forth above for claim 1. Claims 15, 29, 43, and 57 are

therefore allowable for at least reasons similar to those presented above with respect to

claim 1. Claims 16, 17, 19-28, 30, 31, 33-42, 44-46, 48-56, and 59-61 are also

allowable at least due to their dependence from claims 15, 29, 43, and 57.

III. Rejection of Claims 4, 18, 32, and 47 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 4, 18, 32, and 47 as being

unpatentable over *Sansone, Williams, Sansone '401*, and *Manduley* in view of

OFFICIAL NOTICE and *NPL_SDB*. A *prima facie* case of obviousness has not been

established.

Claim 4 depends from claim 1, claim 18 depends from claim 15, claim 32

depends from claim 29, and claim 47 depends from claim 43. As discussed above with

respect to claims 1, 15, 29, and 43, *Sansone, Williams, Sansone '401*, and *Manduley*

fail to teach or suggest at least "determining, using the computer system, routes for

delivery based on a first set of business rules applied to the first set of delivery data and

a second set of business rules applied to the second set of delivery data," as recited in

independent claims 1, 15, 29, and 43 and included in dependent claims 4, 18, 32, and

47.

OFFICIAL NOTICE and *NPL_SDB* fail to cure the deficiencies of *Sansone,*

Williams, Sansone '401, and *Manduley*. OFFICIAL NOTICE was taken that "it is old

and well known that contractual obligations derived from contract set asides and

'socially and economically disadvantaged individuals' ('SDBs') when contracting with

city, state and federal governing bodies may not be at the lowest cost possible . . . ."

(Office Action at page 16). *NPL_SDB* discloses that "the National Defense

Authorization Act of 1987 . . . permits the United States Department of Defense ('DOD')

to preferentially select bids submitted by small businesses owned by socially and

economically disadvantaged individuals ('SDBs'). The 1207 program operates by

increasing the bid of a non-minority-owned firm up to ten percent via a mechanism

called a 'price-evaluation' adjustment."

However, neither the OFFICIAL NOTICE (even if properly taken, which

Applicants do not concede) nor *NPL_SDB* discloses determining routes for delivery

based on different sets of business rules applied to different sets of delivery data.

Therefore, OFFICIAL NOTICE and *NPL_SDB* also fail to teach or suggest "determining,

using the computer system, routes for delivery based on <u>a first set of business rules</u>

applied to the first set of delivery data <u>and a second set of business rules</u> applied to the

second set of delivery data," as recited in claims 1, 15, 29, and 43 and included in

claims 4, 18, 32, and 47 (emphasis added).

In view of the above, the Final Office Action has neither properly determined the

scope and content of the prior art nor properly ascertained the differences between the

claimed invention and the prior art. For at least these reasons, no *prima facie* case of

obviousness has been established. The rejection of dependent claims 4, 18, 32, and 47

under 35 U.S.C. § 103(a) as being obvious from *Sansone, Williams, Sansone '401*, and

Manduley in view of OFFICIAL NOTICE and *NPL_SDB* is thus improper and should be

withdrawn, at least due to their dependence from allowable independent claims 1, 15,

29, and 43.

IV.   Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any additional extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 8, 2011   By: _____
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